

AMENDMENT
U.S. Appln. No. 09/337,667

REMARKS

This Amendment, submitted in response to the Office Action dated January 22, 2001, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

Claims 1-16 remain pending in the application. Claims 6-11, corresponding dependencies of claim 12 and 13-16 have been withdrawn from further consideration at this time, pursuant to the Response to Restriction Requirement filed on November 20, 2000. Claims 1-5 and corresponding dependencies on claim 12 have further been treated on the merits. Claims 12/1, 12/2/1, 12/3/1, 12/4/3/1 and 12/5 have been objected to under 37 C.F.R. § 1.75(c) as being in improper dependent form. Claims 12/1, 12/2/1, 12/3/1, 12/4/3/1 and 12/5 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 1, 3 12/1 and 12/3/1 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Takanashi et al. (U.S.P. 4,527,171, hereinafter "Takanashi"). Claims 2, 4-5, 12/2/1, 12/4/3/1 and 12/5/1 have been rejected under 35 U.S.C. § 103 as being unpatentable over Takanashi in view of Fujimura et al. (U.S.P. 5,397,763, hereafter "Fujimura"). Applicant hereinabove amends the claims to describe the invention more particularly and further respectfully submits the following arguments in traversal of the objections and rejections.

With regard to the objection of claims 12/2 and 12/5, the Examiner maintains that the dependent claims are of improper form. Applicant submits that claims of different statutory classes are proper. All that is required is that the dependent claim further limits the base claim. That requirement is met in the dependent claims 12/2 and 12/5 which describe an apparatus should be used to perform the steps. The Examiner maintains that the apparatus is not required

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to perform the method. However, that is not the test for proper claim dependency. The dependent claim must only be written so that use of the apparatus that infringes the dependent claim also infringes the independent claim. An apparatus of claim 12 used to perform the recited steps of claim 2, for example, would infringe the base claim 2. Therefore, claims 12/2 and 12/5 are of proper dependent form. Applicant further submits that these comments should not be construed to limit the independent claim in any way.

With regard to the Section 112 rejection of claims 12/2 and 12/5, the Examiner maintains that the elements of the apparatus need to be provided in the claims. Applicant submits that reference to another claim does not render the claim indefinite, even if the claims are of different classes. MPEP 2173.05(I). Here, because the base claims are sufficiently definite, the dependent claims which refer to the base claims also satisfy all requirements for Section 112. Moreover, claim 12 does not merely describe a field of use but specifies an apparatus should be used to perform the method steps.

Turning to the prior art rejections. Applicant's invention relates to an image recording method. Detailed descriptions of the background and preferred embodiment of the invention are set forth in the August 4, 2000 Amendment at pages 6-7. Similarly, Fujimura is described in the August 4 Amendment at page 7. Applicant refers the Examiner to these descriptions. Further to these descriptions, Applicant submits that an embodiment of Applicant's invention includes providing a toner sheet with respect to one recording.

Turning to the newly cited art, Takahashi relates to a thermal printing apparatus, including the application of a binder material to a sheet of recording material. The toner sheet is

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provided in a continuous roll form, which is brought into contact with the receiving layer at a portion where a thermal head is placed. See Fig. 1, elements 8a and 7.


The Examiner maintains that the combination of Takanashi and Fujimura teach or suggest each feature of claim 1. However, as amended, claim 1 describes supplying a toner in a sheet form which permits toner sheet application for one recording. By contrast, the toner supply of Takanashi is provided in a continuous roll form. The remaining claims are patentable based on their dependency.

In view of the above, claims 1 and 5-12 in condition for allowance and should be passed to issue at the earliest possible time. Additionally, because claim 1 is generic to claims 6-11, those claims should be rejoined in the application and passed to issue in the present case. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,

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APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The claims are amended as follows:

Claim 1 (Twice Amended). An image recording method comprising the steps of:

attaching recording paper to an outer peripheral surface of a recording drum;

forming an image receiving layer on a surface uniformly on a surface of at least a whole of recording region of the recording paper;

winding a toner sheet, provided as a cut sheet form, onto a surface of the image receiving layer; and

transferring [the] toner on [a] the toner sheet onto [a surface of] the image receiving layer to record an image thereon in accordance with recording data.